

REMARKS

In view of the following remarks and the foregoing amendments, reconsideration and allowance are respectfully requested.

Claims 1-28 are pending at the time of this action, with Claims 1, 18, and 28 being independent. Independent claims 1, 18, and 28 have been amended. Claims 29-35 have been added. Claims 1-35 are currently pending.

Claims 1-4, 9-20, and 24-28 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over DesForges et al., U.S. Patent No. 5,085,587, further in view of Kruger et al., U.S. Patent No. 4,877,948.

Claims 5-8 and 21-23 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over DesForges et al., U.S. Patent No. 5,085,587, further in view of Kruger et al., U.S. Patent No. 4,877,948, and further in view of Poor, U.S. Patent No. 5,452,379.

Claims 1-4, 9-20, and 24-28 stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-15 of U.S. Patent No. 5,085,587, and further in view of Kruger et al., U.S. Patent No. 4,877,948.

35 U.S.C. 103 – claims 1-4, 9-20, 24-28

Regarding the rejection of claims 1-4, 9-20, 24-28 under 35 U.S.C. 103(a) as being unpatentable over DesForges in view of Kruger, Applicants respectfully submit that neither Kruger nor DesForges, nor any proper combination of the two, discloses or properly suggests all of the limitations of independent claims, as amended. This rejection fails to establish a *prima facie* case of obviousness. In particular, the rejection fails to consider portions of Kruger that “teach away” from the proposed combination.

For example, independent claim 1, as amended, recites a scannable form that includes, *inter alia*, a bar code in at least one of a first location and a second location. The first location is at a first pre-determined distance below the end-of-form mark and a second pre-determined distance above a bottom edge of the form. The second location is at a third pre-determined distance from at least one response row and a fourth pre-determined distance from one of the

first and second longitudinal edges. The bar code is sufficiently spaced away from the response rows to avoid false detection of marks in the response rows. The bar code on the scannable form includes **point of sale information** (emphasis added). The amendments to claim 1 do not add new matter and are supported within the specification (*see e.g.*, Specification: page 1, paragraph 2; page 2, paragraph 5; page 11, paragraph 50).

Paragraph "d" on pages 3-4 of the Office Action asserts that Kruger discloses a bar code similar to claim 1, and refers to Fig. 3, cols. 2:30-55, 4:1-25 for this disclosure. However, even assuming for the sake of response that this assertion is correct for the unamended claim, Applicant submits that the cited section of Kruger does not disclose or properly suggest, "the bar code on the scannable form comprises point of sale information," as recited in amended claim 1. Instead, Kruger generally discloses that there are "various kinds of bar code scanners or readers available on the commercial market" in col. 2:30-55. In col. 4:1-25, Kruger discloses that the bar code includes data for employee information for workers, such as employee ID numbers. Fig. 3 shows a "Labor Report Sheet" with the bar codes 34 for an employee 44. Since Kruger teaches that the bar code holds types of data that are different from claim 1, Kruger not only fails to teach the features of claim 1, but teaches away from the features of claim 1. Hence, the burden to establish obviousness has not been met.

Moreover, the Office Action fails to provide evidence to support the rejection under 35 U.S.C. 103 since the cited prior art did not have express teachings to support the assertions of the rejection. For example, pages 3-4 of the Office Action asserts that "barcodes has been widely used as UPC codes that represent prices, used for identification purposes, etc and Examiner here cites the reference Kruger to teach these well known teachings." However, as discussed above, Kruger teaches bar codes having identification data and labor data for employees (Kruger: Fig. 3, cols. 2:30-55, 4:1-25). The Office Action does not point out how Kruger discloses bar codes having "point of sale information." For at least these reasons, Kruger does not support the assertion made in the Office Action with respect to well known teachings, and further, the suggested combination of Kruger with DeForges fails to render claim 1 obvious.

Similarly, amended independent claims 18 and 28 recite features that are similar to claim 1. In accordance with the above, Applicants submit that neither Kruger nor DeForges, nor any proper combination of the two, discloses or properly suggests at least these features of independent claim 1, so that claim 1 is allowable for at least this reason.

Therefore, Applicants submit that independent claims 1, 18, and 28, along with their dependent claims 2-4, 9-17, 19-20 and 24-28 are allowable for at least the above reasons.

35 U.S.C. 103 – claims 5-8 and 21-23

Regarding the rejection of dependent claims 5-8 and 21-23 under 35 U.S.C. 103(a) as being unpatentable over DesForges in view of Kruger and Poor, Applicants respectfully submit that neither Kruger, Poor, nor DesForges, nor any proper combination of the three, discloses or properly suggests all of the limitations of independent claims, as amended. This rejection fails to establish a *prima facie* case of obviousness. In particular, the rejection fails to consider portions of Kruger that “teach away” from the proposed combination as noted above.

As described above, Kruger teaches that the bar code on the form is used for types of data not recited in claim 1, e.g., Kruger discloses employee and related labor data. Further, Applicants submit that DeForges, which is cited for its teachings regarding reciting a scannable form generally, does not cure this deficiency since it does not disclose a bar code on the scannable form, as acknowledged on page 3 of the Office Action.

Moreover, the Applicants submit that Poor fails to remedy the deficiencies of DeForges and Kruger. Page 8 of Office Action alleges that Poor teaches “a form which includes an OCR space which recites an user handwritten character,” and points to Fig. 4, element 34; Fig. 10, element 66; Fig. 12, elements 72, 74; and col. 8:39-45. Assuming for the sake of argument that Poor does teach an OCR space, this teaching does not remedy the deficiencies of DeForges and Kruger as noted above with respect to the amended claim features of the bar code. Poor is silent on disclosing the amended features of the base claims, i.e., claims 1 and 18, with respect to the bar code. Therefore, Applicants submit that neither Kruger, Poor, nor DeForges, nor any proper combination of the three, discloses or suggests at least these features of the claims. For at least

these reasons, the rejection of dependent claims 5-8 and 21-23 under 35 U.S.C. 103(a) should be withdrawn and these claims should be placed in condition for allowance.

Double Patenting – Claims 1-4, 9-20, and 24-28

Claims 1-4, 9-20, 24-28 are patentable over Kruger and claims 1-15 of DeForges under the rejection based on the ground of nonstatutory obviousness-type double patenting. As noted in the M.P.E.P., “any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination” (MPEP 804.II.B.1). In particular, the burden to establish obviousness was not met to support the rejection under 35 U.S.C. 103 since Kruger failed to remedy all of the deficiencies of DeForges, especially in view of all of the amendments made to the independent claims with respect to the bar codes. Since claims 1-4, 9-20, 24-28 are patentable over the suggested combination of Kruger and DeForges for at least the reasons described above with respect to the rejection under 35 U.S.C. 103, claims 1-4, 9-20, 24-28 are also patentable over the nonstatutory obviousness-type double patenting rejection for at least the same reasons. Furthermore, at least because there are amended features in the claims recited herein, there are not conflicting claims between the inventions (MPEP 804.II.B.1). Applicants request withdrawal of the rejection based on the ground of nonstatutory obviousness-type double patenting.

Newly-Added Claims – Claims 29-35

Claims 29-35 are newly-added claims.

For claims 29-31, 33, and 35, the bar code on the scannable form also includes information compatible for **tracking a number of scannable forms sold or remaining in an inventory** (emphasis added). Claims 29-31, 33, and 35 do not add new matter and are supported within the specification (see e.g., Specification: page 1, paragraph 2; page 2, paragraph 5; page 11, paragraph 50).

Moreover, Kruger fails to disclose the dependent claim features of “the bar code on the scannable form comprises information compatible for tracking a number of scannable forms sold

or remaining in an inventory.” As discussed above, Kruger teaches that the bar code is used for other types of data, such as employee and labor data. Further, Applicants submit that DeForges, which is cited for its teachings regarding reciting a scannable form generally, does not cure this deficiency since it does not disclose a bar code on the scannable form, as acknowledged on page 3 of the Office Action. Therefore, Applicants submit that neither Kruger nor DeForges, nor any proper combination of the two, discloses or suggests at least these features of the claims.

Claims 32 and 34 do not add new matter and have features that are supported within the specification (*see e.g.*, specification: page 1, paragraph 2; page 2, paragraph 5; Figs. 7A-7C; pages 11-12, paragraphs 48-53; Figs. 8B, 9; page 12, paragraphs 54-56). For example, Fig. 7C shows a scannable form 730B with barcode zones 736C and 738, and Fig. 9 shows a scannable form 900 with barcode zones 904A and 904B.

Applicants ask that claims 29-35 be placed in condition for allowance.

In Conclusion

In view of the amendments and remarks herein, the Applicants believe that Claims 1-35 are in condition for allowance and ask that these pending claims be allowed. The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claims or other claims.

No fee is believed due at this time. Please apply any charges or credits to Deposit Account No. 06-1050.

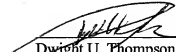
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Respectfully submitted,

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